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EXAMINER

RUTLEDGE, AMELIA L

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/690,980	Applicant(s) SUNDERMEYER ET AL.	
	Examiner Amelia Rutledge	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 10/04/2006.
2. Claims 1-26 are pending. Claims 1, 8, 15, and 22 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. (hereinafter "Brown"), U.S. Pub. No. 2004/0177321, published September 2004, in view of *Dreamweaver TechNote16416*, "How to make an inherited editable region uneditable," (hereinafter "Dreamweaver"), last updated 07/06/2002, p. 1-4.**

Regarding independent claim 1, Brown teaches a method of inserting XML restriction tags into an editable, i.e., revised, document (p. 9, par. 107-p. 10, par. 109) including instance level restrictions. Brown teaches a method of creating a bounding file or DTD to restrict editing of a formatted structured document (p. 8, par. 94-p. 9, par. 105), by parsing the input document and generating a bounding file (p. 6, par. 74-78). Therefore Brown teaches parsing the multi-formatted document, identifying a plurality of tags responsive to the parsing, and generating a revised document based on the multi-formatted document, and inserting restriction tags into the revised document delimiting

non-editable content defined by one or more of the tags, because Brown teaches parsing an input document and generating a bounding document, a revised document which can be edited and contains restriction tags delimiting non-editable content defined by the tags.

While Brown teaches that the restriction tags in the bounding document are used to determine non-editable content in either structured documents or a GUI, (p. 5, par. 63), i.e., restrict the functions of a page editor; Brown does not explicitly teach a method of restricting edit functions of a page editor editing the revised document where the restricting is responsive to the page editor reading the restriction tags. In other words, although Brown does teach generating an editable bounding file containing restriction tags, the bounding file *itself* is not edited by the page editor reading the restriction tags. Rather, the bounding file disclosed by Brown contains restriction tags to be used by the page editor for editing another document or GUI page.

However, Dreamweaver teaches the use of nested templates with editable and non-editable regions delimited by tags which are inserted into a revised document (p. 1-3), and which restrict the edit functions of the Dreamweaver page editor editing the revised document where the restricting is responsive to the page editor reading the restriction tags. In other words, the page editor disclosed by Dreamweaver reads the restriction tags which have been inserted into the revised document, in order to edit the revised document *itself* and determine non-editable content in the revised document.

The reference *Macromedia Dreamweaver MX: Training from the Source*, published July 23, 2002, Safari Tech Books Online version,

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<http://proquest.safaribooksonline.com>, p. 1-39; while not being relied upon for the rejections, is cited for the purpose of providing additional information on Dreamweaver and Dreamweaver templates.

Both Brown and Dreamweaver are directed toward editing structured document files. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the templates with editable regions taught by Dreamweaver with the XML bounding DTD with restriction tags taught by Brown, so that the editing GUI would have functionality to control and restrict editing both of HTML (Dreamweaver) and XML (Brown), and so that the user would have the benefit of a simpler way to edit XML files and the application developer would have control over user actions while editing the files (Brown, p. 2, par. 18).

Regarding dependent claim 2, Brown teaches compiling a list of document locations containing editable content defined by the tags (Fig. 14).

Regarding dependent claim 3, Brown teaches hiding of restriction tags so that the user of a page editor cannot see the tags during editing (p. 6, par. 72).

Regarding dependent claims 4 and 5, Brown teaches setting a restriction flag in the revised document to activate edit restriction, by designating a tag editable or non-editable, which is read by the application (p. 8, par. 91-93).

Regarding dependent claim 6, Brown teaches the use of shading to notify the user of a restrictive editing location (p. 7, par. 80).

Regarding dependent claim 7, while Brown does not teach stripping out the restriction tags when said page editor writes said edited multi-formatted document for presentation, since brown teaches a bounding file, Dreamweaver teaches stripping out the restriction tags when the document is written for presentation, since Dreamweaver teaches stripping out code from nested template documents (p. 3, "Making the region uneditable, but controlling the visibility of its content while in the nested template), and discloses that by modifying or moving code within an editable region, developers can control whether pieces of code are visible or hidden. Both Brown and Dreamweaver are directed toward editing structured document files. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the templates with editable regions taught by Dreamweaver with the XML bounding DTD with restriction tags taught by Brown, so that the editing GUI would have functionality to control and restrict editing both of HTML (Dreamweaver) and XML (Brown), and so that the user would have the benefit of a simpler way to edit XML files and the application developer would have control over user actions while editing the files (Brown, p. 2, par. 18).

In regard to independent claim 8, Brown teaches a method of inserting XML restriction tags into an editable document (p. 9, par. 107-p. 10, par. 109) including instance level restrictions. Brown teaches a method of creating a bounding file or DTD

to restrict editing of a formatted structured document (p. 8, par. 94-p. 9, par. 105), by parsing the input document and generating a bounding file (p. 6, par. 74-78). Therefore Brown teaches parsing the multi-formatted document, identifying a plurality of labels, analyzing the labels, and generating a revised document using content of the multi-formatted document, because Brown teaches parsing an input document and generating a bounding document, a revised document which can be edited and contains restriction tags delimiting non-editable content defined by the tags.

While Brown teaches that the restriction tags in the bounding document are used to determine non-editable content in either structured documents or a GUI, (p. 5, par. 63), i.e., restrict the functions of a page editor; Brown does not explicitly teach code for inserting a prohibition label in said modified document around each instance of non-editable content as defined by said one or more descriptive labels; and code for prohibiting edit functions of a document editor editing said modified document, wherein said code for prohibiting is executed responsive to said prohibition labels. In other words, although Brown does teach generating an editable bounding file containing restriction tags, the bounding file *itself* is not edited by the page editor reading the restriction tags. Rather, the bounding file disclosed by Brown contains restriction tags to be used by the page editor for editing another document or GUI page.

However, Dreamweaver teaches the use of nested templates with editable and non-editable regions delimited by labels which are inserted into a revised document (p. 1-3), and which restrict the edit functions of the Dreamweaver page editor editing the revised document where the restricting is responsive to the page editor reading the

restriction tags. In other words, the page editor disclosed by Dreamweaver reads the restriction tags which have been inserted into the revised document, in order to edit the revised document *itself* and determine non-editable content in the revised document. Therefore Dreamweaver teaches code for inserting a prohibition label in said modified document around each instance of non-editable content as defined by said one or more descriptive labels; and code for prohibiting edit functions of a document editor editing said modified document, wherein said code for prohibiting is executed responsive to said prohibition labels.

The reference *Macromedia Dreamweaver MX: Training from the Source*, published July 23, 2002, Safari Tech Books Online version, <http://proquest.safaribooksonline.com>, p. 1-39; while not being relied upon for the rejections, is cited for the purpose of providing additional information on Dreamweaver and Dreamweaver templates.

Both Brown and Dreamweaver are directed toward editing structured document files. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the templates with editable regions taught by Dreamweaver with the XML bounding DTD with restriction tags taught by Brown, so that the editing GUI would have functionality to control and restrict editing both of HTML (Dreamweaver) and XML (Brown), and so that the user would have the benefit of a simpler way to edit XML files and the application developer would have control over user actions while editing the files (Brown, p. 2, par. 18).

Regarding dependent claims 9-14, claims 9-14 reflect substantially similar subject matter as claimed in dependent claims 2-7, being directed to the computer program product used to implement the methods as claimed in dependent claims 2-7, and are rejected along the same rationale.

Independent claim 15 cites: *A method to restrict editing of a Web document comprising: parsing said Web document; analyzing a plurality of markup tags within said Web document; generating a substitute Web document with content of said Web document; inserting one or more restriction markup tags in said substitute Web document demarcating non-editable content items defined by one or more of said plurality of markup tags; and restricting edit functions of a Web editor editing said substitute Web document, wherein said restricting is responsive to said one or more restriction markup tags; and displaying said non-editable content to provide context for an editable portion of said web document.*

Brown teaches a method of inserting XML restriction tags into an editable, i.e., revised, document (p. 9, par. 107-p. 10, par. 109) including instance level restrictions. Brown teaches a method of creating a bounding file or DTD to restrict editing of a formatted structured document (p. 8, par. 94-p. 9, par. 105), by parsing the input document and generating a bounding file (p. 6, par. 74-78). Therefore Brown teaches parsing the multi-formatted document, identifying a plurality of tags within the document, and generating a revised document based on the multi-formatted document, and inserting restriction tags into the revised document delimiting non-editable content

defined by one or more of the tags, because Brown teaches parsing an input document and generating a bounding document, a revised document which can be edited and contains restriction tags delimiting non-editable content defined by the tags.

While Brown teaches that the restriction tags in the bounding document are used to determine non-editable content in either structured documents or a GUI, (p. 5, par. 63), i.e., restrict the functions of a page editor; Brown does not explicitly teach a method of restricting edit functions of a Web editor editing said substitute Web document. In other words, although Brown does teach generating an editable bounding file containing restriction tags, the bounding file *itself* is not edited by the page editor reading the restriction tags. Rather, the bounding file disclosed by Brown contains restriction tags to be used by the page editor for editing another document or GUI page.

However, Dreamweaver teaches the use of nested templates with editable and non-editable regions delimited by tags which are inserted into a revised document (p. 1-3), and which restrict the edit functions of the Dreamweaver page editor editing the revised document where the restricting is responsive to the page editor reading the restriction tags. In other words, the page editor disclosed by Dreamweaver reads the restriction tags which have been inserted into the revised document, in order to edit the revised document *itself* and determine non-editable content in the revised document.

Further, while Brown does not explicitly teach displaying said non-editable content to provide context for an editable portion of said web document, Dreamweaver discloses displaying the non-editable content to provide context for an editable portion of said web document, since Dreamweaver clearly discloses that both editable and non-

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editable content may be made visible to the user, as disclosed on p. 2-3. Dreamweaver explicitly teaches a method titled "Making the region uneditable, and retaining the visibility of its content while in the nested template", on p. 2.

The reference *Macromedia Dreamweaver MX: Training from the Source*, published July 23, 2002, Safari Tech Books Online version, <http://proquest.safaribooksonline.com>, p. 1-39; while not being relied upon for the rejections, is cited for the purpose of providing additional information on Dreamweaver and Dreamweaver templates.

Both Brown and Dreamweaver are directed toward editing structured document files. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the templates with editable regions taught by Dreamweaver with the XML bounding DTD with restriction tags taught by Brown, so that the editing GUI would have functionality to control and restrict editing both of HTML (Dreamweaver) and XML (Brown), and so that the user would have the benefit of a simpler way to edit XML files and the application developer would have control over user actions while editing the files (Brown, p. 2, par. 18).

Regarding dependent claims 16-21, claims 16-21 reflect substantially similar subject matter as claimed in dependent claims 2-7, and are rejected along the same rationale.

5. **Claims 22-24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakao, U.S. Patent No. 6,061,697, issued May 2000, in view of Brown**

Independent claim 22 cites: *A system for preserving design elements of a Web page during content editing, said system comprising: a Web development environment comprising: a parsing engine for analyzing a plurality of Web page markup tags; a list of restriction tags for insertion around said design elements, as defined by one or more of said plurality of Web page markup tags; and a page editor comprising: a plurality of deselectable editing functions, wherein said deselection is responsive to said restriction tags.*

Nakao teaches a SGML document editing apparatus which is implemented with a method of parsing a formatted SGML document (Col. 5, l. 5-22; Col. 7, l. 13-25) and identifying a plurality of editable tags in the document (Col. 9, l. 1-45). Nakao teaches a list of restriction tags for insertion around formatting elements (Col. 9, l. 1-45). While Nakao teaches a page editor, Nakao does not explicitly teach a page editor comprising a plurality of deselectable editing functions, where deselection is responsive to restriction tags. However, Brown teaches a web development environment and page editor with deselectable editing functions responsive to the restriction tags (p. 6, par. 72; p. 7, par. 80). Brown teaches a method of inserting XML restriction tags into the editable, i.e., revised, document (p. 9, par. 107-p. 10, par. 109) including instance level restrictions. Brown teaches a method of creating a bounding file or DTD to restrict editing of a formatted structured document (p. 8, par. 94-p. 9, par. 105), by parsing the

input document and generating a bounding file (p. 6, par. 74-78). Both inventions are directed toward restricting editing operations on structured documents. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Brown to Nakao, so that the user would have the benefit of techniques that enable application developers to have some control over what users can do when editing a structured document file (Brown p. 2, par. 21).

Regarding dependent claim 23, Nakao teaches a method of parsing a formatted SGML document (Col. 5, l. 5-22; Col. 7, l. 13-25) and identifying a plurality of editable tags in the document (Col. 9, l. 1-45); compare to: *a Web page is processed by said Web development environment to obtain said restriction tags*.

Regarding dependent claim 24, while Nakao does not explicitly teach that a subject matter expert operates said page editor to perform said content editing, Brown teaches that the editing system is designed for both application developers and users, where the users operate the restrictive page editor (p. 2, par. 21). The users taught by brown correspond to subject matter experts and would include that group. Both inventions are directed toward restricting editing operations on structured documents. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Brown to Nakao, so that the user would have the benefit of techniques that enable application developers to have some control over what users can do when editing a structured document file (Brown p. 2, par. 21).

Regarding dependent claim 26, while Nakao does not explicitly teach a restriction switch, Brown teaches a restriction switch for deselecting editing functionality (Figure 14) compare to *a restriction switch, accessible by said Web development environment, for activating deselectability of said plurality of deselectable editing functions*.

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakao in view of Brown, and further in view of Judson, U.S. Patent No. 5,752,643, issued November 1996.

Regarding dependent claim 25, while Nakao in view of Brown does not explicitly teach a cover object for obscuring the restriction tags from view, Judson teaches hiding tags in HTML comment tags and/or by the creation of a covering tag to obscure another tag from view (Col. 5, l. 16-40), compare to *a cover object for obscuring said restriction tags from view in said page editor*. Nakao, Brown, and Judson are all directed toward the presentation and display of structured web documents. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Nakao, Brown, and Judson, so that the user would have the benefit of viewing the hidden information instantly, without the added time that would have been required to download the information, and information could be viewed as required by the user (Judson, col. 2, l. 12-28).

Response to Arguments

7. Applicants' arguments filed 10/04/2006 have been fully considered but they are not persuasive. In response to applicants' arguments that the examiner has made contradictory statements in the Office Action in regard to the rejections of record (Remarks, p. 6-7), applicant cites only partial text of the statements in question, without even reciting the complete sentences, and then paraphrases the cited text. When read through completely the statements in regard to the Brown reference from the previous Office Action were not contradictory. However, in response to applicants' arguments clarification and further explanation of the rejections of claim 1 follows, and has been incorporated above. The same grounds of rejection are maintained from the previous Office Action and no new grounds of rejection are added.

Brown teaches a method of inserting XML restriction tags into an editable, i.e., revised, document (p. 9, par. 107-p. 10, par. 109) including instance level restrictions. Brown teaches a method of creating a bounding file or DTD to restrict editing of a formatted structured document (p. 8, par. 94-p. 9, par. 105), by parsing the input document and generating a bounding file (p. 6, par. 74-78). Therefore Brown teaches parsing the multi-formatted document, identifying a plurality of tags responsive to the parsing, and generating a revised document based on the multi-formatted document, and inserting restriction tags into the revised document delimiting non-editable content defined by one or more of the tags, because Brown teaches parsing an input document and generating a bounding file, a revised document which can be edited and contains restriction tags delimiting non-editable content defined by the tags.

While Brown teaches that the restriction tags in the bounding document are used to determine non-editable content in either structured documents or a GUI, (p. 5, par. 63), i.e., restrict the functions of a page editor; Brown does not explicitly teach a method of restricting edit functions of a page editor editing the revised document where the restricting is responsive to the page editor reading the restriction tags. In other words, although Brown does teach generating an editable bounding file containing restriction tags, the bounding file *itself* is not edited by the page editor reading the restriction tags. Rather, the bounding file disclosed by Brown contains restriction tags for used by the page editor for editing another document.

However, Dreamweaver teaches the use of nested templates with editable and non-editable regions delimited by tags which are inserted into a revised document (p. 1-3), and which restrict the edit functions of the Dreamweaver page editor editing the revised document where the restricting is responsive to the page editor reading the restriction tags.

Applicants allege that the examiner has not responded to applicants' previous arguments with respect to the patentability of claims 22-25 filed in the Amendment Accompanying RCE filed 04/27/2006 (Remarks, p. 7, par. 1). Pages 12-13 of the previous Office Action mailed 07/27/2006 contain the responses to applicants' arguments regarding claims 22-25.

In response to applicants' arguments against the combination of Brown and Dreamweaver in regard to the rejections of claims 1 and 8 (Remarks, p. 7-9), applicant argues that neither Brown nor Dreamweaver discloses inserting restriction tags into a

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revised document, or a prohibition label in a modified document. The examiner maintains that both Brown and Dreamweaver teach inserting restriction tags into a revised document because Brown teaches inserting restriction tags into an editable bounding file, and Dreamweaver teaches inserting restriction tags into an editable nested template. Applicants' arguments are based on the premise that nested templates and bounding files are not revised documents, however, under the broadest reasonable interpretation of the claimed term "revised document", it is the examiner's opinion that both Brown and Dreamweaver do disclose inserting restriction tags into a revised document, or a prohibition label in a modified document, since both teach that the restriction tags and documents were editable, and the operation of inserting the tags resulted in a revised document.

See In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").

It is also respectfully noted that applicants provided no explicit definition for the term "revised document" in the original disclosure. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term

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as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999). Since no definition was provided the claim term must be given the broadest reasonable interpretation as discussed above.

In response to applicants' arguments against the combination of Brown and Dreamweaver in regard to the rejections of claim 15 (Remarks, p. 9), it is respectfully noted that applicants have apparently misread the cited portion of the Dreamweaver reference, p. 3, second figure. Applicants argue that the symbol "@@" replaces *non-editable* content. However, it is clear upon looking at the second figure and reading the cited reference that the "@@" symbol denotes *editable* content. Also see p. 2, item 7. The Dreamweaver reference clearly discloses that both editable and non-editable content may be either hidden or made visible to the user, as disclosed on p. 2-3. Dreamweaver explicitly teaches a method titled "Making the region uneditable, and retaining the visibility of its content while in the nested template", on p. 2. Therefore the combination of Brown and Dreamweaver does teach all of the limitations of claim 15.

In response to applicants' argument in regard to the motivation statement for the combination of Brown and Dreamweaver (Remarks, p. 10-11), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the suggestion may be found in Brown, p. 2, par. 18. The cited passage of Brown reads: *Accordingly, what is needed is a cost-effective way to enable users to edit XML files (or files encoded in other markup languages), while shielding them from details of the XML language (e.g., the tags and attributes of a particular data model) and at the same time, enabling application developers to have some control over what the users can do when they are editing XML files.* Therefore, contrary to applicants' argument, Brown does indicate a need to control and restrict editing both of HTML and XML, i.e., *what is needed is a cost-effective way to enable users to edit XML files (or files encoded in other markup languages)* and therefore does provide motivation for the combination of references.

For similar reasons and the reasons of record, the rejections of the respective dependent claims are maintained.

In response to applicants', arguments regarding claim 22, and in regard to the Nakao reference (Remarks, p. 11-13), applicants' arguments recite passages of Nakao which were not relied upon for the claim rejection, and further, the passages of Nakao relied upon for the basis of applicants' arguments refer to the Background of Invention section of the reference, not the disclosure of Nakao. Therefore it appears that applicants' arguments related to the cited passage are moot. It is the examiner's opinion that the combination of Nakao and Brown discloses the limitation *identifying a plurality of web page markup tags*, for the reasons set forth in the rejection of claim 22, above, and in the citations relied upon for the rejection. Further, Nakao teaches a list of restriction tags for insertion around formatting elements (Col. 9, l. 1-45).

In response to applicants' argument in regard to the motivation statement for the combination of Nakao and Brown (Remarks, p. 14), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion may be found in Brown, p. 2, par. 21.

For similar reasons and the reasons of record, the rejections of the respective dependent claims are maintained.

Applicant's arguments regarding the Judson patent used to reject claim 25 (Remarks, p. 15-16) do not dispute the teaching of Judson but rather only refer back to the purported deficiencies of Nakao and Brown, which have been addressed above. In response to applicants' argument in regard to the motivation statement for the combination of Nakao, Brown, and Judson (Remarks, p. 15-16), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion may be found in Judson, col. 2, l. 12-28.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia Rutledge whose telephone number is 571-272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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